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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/786,102

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Keisuke Horigami

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EXAMINER

STRODER, CARRIE A

ART UNIT

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12/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/786,102	Applicant(s) HORIGAMI ET AL.	
	Examiner CARRIE A. STRODER	Art Unit 4154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on 26 February 2004, wherein:

Claims 1-9 are currently pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-5 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. To obtain a patent, it must be directed to a new and useful process, machine, manufacture, or composition of matter. However, applicant does not direct claims 1-5 to any statutory category. Applicant ostensibly intends claims 1-5 to be directed toward a machine or manufacture, as the preamble recites an "apparatus." However, applicant does not recite any structure for the apparatus. Further, a preamble that recites merely the use of purpose of the claimed invention generally does not limit the claims. *Catalina*, 62 USPQ2d at 1785. Therefore, the Examiner can give no weight to the preamble.

4. **Claims 6-7 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claims 6-7 are directed to a computer program. However, computer programs are nonstatutory *per se*. See MPEP 2106.01.

5. **Claims 8-9 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials).

Diamond v. Diehr, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 8-9, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claims 1-9 are rejected** under 35 U.S.C. 103(a) as being unpatentable over King et al. (US 5864755).

Referring to claim 1:

King teaches a registration management apparatus comprising:

an information acquisition section that acquires product information concerning a product to be registered (col. 2, lines 8-11);

an authorized registration propriety decision section that decides propriety of authorized registration of said product on a basis of the product information acquired by said information acquisition section (col. 1, lines 17-18; the decision section is implied as the phone system must determine whether phones are properly registered or not);

a condition information storage section that stores temporary registration condition information specifying conditions for temporary registration of said product (col. 2, lines 3-13; dialing emergency service is interpreted as a condition); and

a temporary registration section that temporarily registers said product if it is decided to be improper for authorized

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registration by said authorized registration propriety decision section and the product information concerning' said product conforms to said temporary registration conditions (col. 2, lines 66-67 and col. 3, lines 1-4).

Referring to claim 2:

Claim 2 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein.

King teaches further comprising:

a historical information storage section that stores historical information concerning temporary registration processing executed by said temporary registration section (col. 2, lines 28-31; implied since the assignment between the DID and the unique identifying number is terminated after a predetermined time); and

an information updating section that updates said temporary registration condition information on a basis of said historical information stored in said historical information storage section (col. 2, lines 28-31; implied since the assignment between the DID and the unique identifying number is terminated after a predetermined time).

Referring to claim 3:

Claim 3 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein.

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King teaches a wherein said temporary registration condition information includes at least ID information concerning products (col. 2, lines 8-11; "unique identifying number" is interpreted as ID information).

Referring to claim 4:

Claim 4 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein.

King teaches wherein said temporary registration condition information includes at least information specifying conditions needed to decide propriety of temporary registration of said product (col. 2, lines 66-67 and col. 3, lines 1-4; wherein the placement of an emergency call is interpreted as the condition).

Referring to claim 5:

Claim 5 is dependent on claim 1; therefore the rejection of claim 1 is incorporated herein.

King teaches wherein said product information is a product ID (col. 2, lines 8-11; "unique identifying number" is interpreted as a product ID).

Referring to claims 6-7:

Claims 6 and 7 are for the program associated with claims 1 and 2, respectively. Therefore, claims 6 and 7 are rejected on the same basis as claims 1 and 2.

Referring to claims 8-9:

Claims 8 and 9 are for the method associated with claims 1 and 2, respectively. Therefore, claims 8 and 9 are rejected on the same basis as claims 1 and 2.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Saitou et al. (US 20020087543);
- b. Rechterman et al. (US 20040199608);
- c. Hecksel et al. (US 6151707); and
- d. Highbloom (US 5623403).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 7:00 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571)272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 4154

/Vu Le/
Supervisory Patent Examiner,
Art Unit 4154